

REMARKS

Claims 4, 5, 8, 14, 15, and 18 have been amended. No claims have been cancelled pursuant to the present reply. Thus, claims 1-31 are pending in the present application.

Claim 4, 5, 8, 14, 15, and 18 have been amended to better clarify that which is being claimed and to make these claims consistent with the claims from which they depend.

Drawing Amendment

The Applicants have attached a replacement drawing sheet (sheet 5/8) that includes a correction to FIG. 8. In FIG. 8, previously omitted element 42—the slot machine symbol 42—has been added. Support for this drawing correction can be found in the Applicants' specification on page 7, line 4 and in FIG. 11. The Applicants respectfully submit that this drawing amendment does not add new matter to the present application.

Claim Rejections — 35 U.S.C. § 102 (Moody)

Claims 1-9 and 11-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,976,016 to Moody *et al.* The Applicants respectfully traverse these claim rejections for at least the following reasons.

Claims 1 and 11 require “displaying a plurality of selectable elements associated with respective outcomes” (emphasis added). For example, as discussed in the Applicants' specification, the outcome for each of the selectable elements 30a, 30c, and 30h are no payoff; the outcome for the selectable element 30f is a payoff of 10 credits; and the outcome for the selectable element 30g is a fruit 40. *See* page 6, lines 14-19 and FIG. 6. This requirement of claims 1 and 11 is not disclosed by Moody. In Moody, each combination of symbols aligned along a payline is associated with a winning combination. The selectable Moody symbols are not each associated with an outcome.

Further, the “plurality of selection elements [being] associated with respective outcomes” requirement of claim 1 is manifest from the final element of claims 1 and 11, which requires that outcomes—plural—are awarded: “awarding the outcomes associated with the selected element and the at least one of the non-selected elements.” Put simply, claims 1 and 11 require that at least two outcomes be awarded: one associated with the selected element and one associated with the non-selected element. Moody does not disclose this requirement of claims 1 and 11.

Thus, the Applicants respectfully submit that claims 1 and 11, and the claims that depend therefrom, are patentable over Moody under 35 U.S.C. § 102(b) for at least this reason.

Claims 2 and 11 require “revealing the outcomes associated with the selected element and the at least one of the non-selected element at their respective locations” in response to the selection. Moody does not disclose that an outcome associated with a symbol is revealed at a symbol location in response to selection of that symbol. Moody does not disclose that each symbol is associated with an outcome, and the Moody symbols are known to a player at the time of selection. Thus, the Applicants respectfully submit that claims 2 and 11 are patentable over Moody under 35 U.S.C. § 102(b) for at least this reason as well.

Claim Rejections — 35 U.S.C. § 102 (Schneider)

Claims 21-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,089,976 to Schneider *et al.* The Applicants respectfully traverse these rejections for at least the following reasons.

Claim 21 requires “conducting the primary game again” in response to a start-primary outcome in the secondary game. Schneider does not disclose a start-primary outcome in its bonus game, and the Schneider primary game is not conducted again in response to the player’s selection of two matching bonus awards in the Schneider bonus game. As clearly illustrated in FIG. 7—cited in the Office Action—the Schneider primary game is conducted in response to a wager placed by a player of the Schneider gaming machine. The Schneider gaming machine operates as follows:

A primary game is initiated by a player establishing credit on the gaming machine 10 via either entering tokens, coins, currency or the like into the wagering input means 18 and making a wager via the bet switches 32,34. . . . [I]f the outcome of the primary game is a qualifying outcome the display of the video monitor 14 transforms into the bonus award display 50 shown in FIG. 2.

* * *

The player [in the bonus game] continues to touch images one at a time until two matching bonus amounts are obtained. A credit meter is then incremented or the player is paid directly based on the matching bonus amounts. The player is then asked for a subsequent wager.

Column 4, lines 37-41 and 43-46; and column 5, lines 59-63.

Schneider clearly discloses that the primary game is conducted in response to receipt of a wager after the conclusion of the bonus game, and is not conducted again in response to a start-

primary outcome in the secondary game as required by claim 21. Thus, the Applicants respectfully submit that claim 21, and the claims that depend therefrom, are patentable over Schneider under 35 U.S.C. § 102(b) for at least the foregoing reasons.

Claim 26 requires that the primary game be “free of slot reels and playing cards.” Similarly, claim 31 requires that the primary game be “other than a slot reel game and a playing card game.” Conversely, Schneider discloses that the primary game includes slot reels and playing cards:

Preferably, the primary game is a video draw poker game incorporating a video depiction of five reels 40 having card symbols C displayed thereon. . . .
Alternatively, the primary game can be a conventional video style three reel-type slot machine employing symbols in the form of bells, fruits, numbers, etc.

Column 5, lines 9-33; *See also*, FIG. 1. Because the Schneider primary game is not “free of slot reels and playing cards” as required by claim 26 or is not “other than a slot reel game and a playing card game” as required by claim 31, Schneider does not disclose every element of claims 26 and 31. *See, e.g., In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) (“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.”).

Claims 26 and 31 also require a secondary game (*i.e.*, the bonus game) that includes “a plurality of symbol bearing reels that are rotated and stopped to place symbols on the reels in visual association with a display area.” The Schneider bonus game does not include symbol bearing reels. *See, e.g.*, Schneider at column 4, lines 47-54 and FIGS. 2-5 (“the bonus award display 50 is comprised of a multiplicity of images 52 which have bonus amounts initially obscured from the view of the player.”) Because Schneider does not disclose a bonus game that includes “a plurality of symbol bearing reels that are rotated and stopped to place symbols on the reels in visual association with a display area,” Schneider does not disclose every element of claims 26 and 31.

Thus, the Applicants respectfully submit that claim 26 and 31, and the claims that depend therefrom, are patentable over Schneider under 35 U.S.C. § 102(b) for at least the foregoing reasons.

Further, the Applicants respectfully submit that claims 26 and 31, and the claims that depend therefrom, are also nonobvious in view of Schneider because Schneider, in teaching that the primary game includes slot reels and playing cards, teaches away from claims 26 and 31.

See, e.g., Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH, 139 F.3d 877, 885, 45 U.S.P.Q.2d 1977, 1984 (Fed. Cir. 1998) (A prior art reference may be considered to teach away when “a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”). Thus, the Applicants respectfully submit that claims 26 and 31, and the claims that depend therefrom, are also patentable over Schneider under 35 U.S.C. § 103.

Claim Rejections — 35 U.S.C. § 103 (Moody & Schneider)

Claims 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody as applied to claims 1 and 11, and further in view of Schneider. The Applicants respectfully traverse these claim rejections.

Claims 10 and 20 depend from claims 1 and 11, respectively. Assuming, *arguendo*, that Schneider “teaches the use of an animated pattern” as recited in the Office Action, Schneider still does not make up for the deficiencies of Moody in rejecting claims 1 and 11 as is discussed above. Thus, for at least the reasons discussed above in connection with claims 1 and 11, the Applicants respectfully submit that claims 10 and 20 are patentable under 35 U.S.C. § 103(a) over Moody in view of Schneider.

Conclusion

In conclusion, the Applicants respectfully submit in view of the remarks set forth herein that all rejections have been overcome and that all claims are in condition for allowance, and such action is earnestly solicited.

If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants’ undersigned attorney at the number indicated.’

The Applicants respectfully submit that no fee is due in connection with the present Reply. The Commissioner is authorized to charge any required fees while this application is pending (except the issue fee) to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47079-00129USPT).

Respectfully submitted,
JENKENS & GILCHRIST, P.C.,

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By: 

Timothy M. Kowalski
Reg. No: 44,192
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-8518
(312) 425-3909 (fax)
tkowalski@jenkens.com
ATTORNEYS FOR APPLICANTS